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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,373	02/21/2007	Kenzo Takahashi	0388-060908	2738

28289 7590 03/24/2010  
THE WEBB LAW FIRM, P.C.  
700 KOPPERS BUILDING  
436 SEVENTH AVENUE  
PITTSBURGH, PA 15219

EXAMINER
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KING, FELICIA C

ART UNIT	PAPER NUMBER
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1794

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03/24/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,373	<b>Applicant(s)</b> TAKAHASHI ET AL.	
	<b>Examiner</b> FELICIA C. KING	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 13-31 is/are pending in the application.
- 4a) Of the above claim(s) 23-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/11/08; 12/4/09; 1/19/10</u> .                               | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on 1/19/10 is acknowledged. The traversal is on the ground(s) that both groups require a nutritive substance and that the specification states that coffee pulp can be a nutritive substance, and because both groups disclose coffee pulp. This is not found persuasive because although applicant argues that the recitation of coffee pulp gives the groups the same corresponding technical feature, Group II contains refining steps which are technical features that are not found in Group I.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 13, 14, 16, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirby (US 2,231,148).**

**Regarding Claims 13, 17, and 18:** Kirby discloses fermenting pulped green coffee beans with a microorganism in the form of yeast and in the presence of a nutritive substance which is malt (sugar or grain) [pg.1, col.1, lines 38-55].

**Regarding Claim 14:** Kirby discloses fermenting pulped coffee beans with a microorganism in the form of yeast and in the presence of a nutritive substance which is malt (sugar or grain) [pg.1, col.1, lines 38-55] and further discloses washing the fermented beans by placing them in a tank [col.2, lines 24-40]. This is considered commensurate with the claim as Applicant's

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specification states that washing with water is an acceptable method of separation/segregation of coffee beans [10573373 pg 20 lines 11-17].

**Regarding Claim 16:** Kirby discloses fermenting process where a microorganism which is yeast is combined and in contact with a nutritive substance which is malt and is then brought into contact with pulped coffee beans [pg.1, col.1, lines 54-55, col. 2 line 1 ].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made

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in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirby (US 2,231,148).**

**Regarding Claim 15:** Kirby discloses fermenting pulped green coffee beans with a microorganism in the form of yeast and in the presence of a nutritive substance which is malt (sugar or grain) [pg.1, col.1, lines 38-55] but does not explicitly disclose contacting coffee beans and nutritive substance and then contacting with a microorganism which is yeast. However, Kirby discloses that during the pulping process there is pulp remaining on the coffee bean and that the pulp acts as a nutritive substance for yeast. It would have been obvious to one of ordinary skill in the art to mix the fermentation materials in any order given they are all mixed together and that there does not appear to be criticality with the order of mixing the materials.

**8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirby (US 2,231,148) as applied to claim 18 above and in further view of Mori (JP 11043390 Derwent Abstract).**

**Regarding Claim 19:** Kirby discloses a method of fermenting green coffee as discussed above but does not disclose adding dried pulp. However, Mori discloses quicker fermentation by using an additive having soluble coffee bean pulp that is mixed with shavings which implies a dry composition.

At the time of the invention it would have been obvious to one of ordinary skill in the art having the teachings of Kirby and Mori before him or her to modify the method of Kirby to incorporate dried pulp in order to better ferment the coffee beans as Kirby teaches that the combination of pulp and yeast advantageously increases the rate of fermentation.

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**9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirby (US 2,231,148) as applied to claim 17 above and in further view of Hagiwara (US 2004/0180112).**

**Regarding Claim 20:** Kirby discloses a method of fermenting green coffee beans as discussed above but does not disclose that the yeast used is brewer's yeast. However, Hagiwara discloses beer yeast (brewer's yeast) fermented with coffee extract [pg. 1, para 0009, 0014].

At the time of the invention it would have been obvious to one of ordinary skill in the art having the teachings of Kirby and Hagiwara before him or her to modify the yeast of Kirby for the yeast of Hagiwara because brewer's yeast is commonly used in fermentation process for the formation of beverage products and would provide a flavor distinct to what is produced by brewer's yeast to the coffee beans upon fermentation.

**10. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirby (US 2,231,148) in view of Zapp et al. (US 6,660,322).**

**Regarding Claim 21:** Kirby discloses fermenting pulped coffee beans (considered green because they have not undergone processing) with a microorganism in the form of yeast and in the presence of a nutritive substance which is malt (sugar or grain) [pg.1, col.1, lines 38-55] but does not disclose roasting the fermented green coffee beans. However, Zapp discloses roasting green coffee beans and that the coffee beans are fermented [col. 1, Ex 1; claims 1-7].

At the time of the invention it would have been obvious to one of ordinary skill in the art having the teachings of Kirby and Zapp before him or her to roast the fermented green beans of Kirby in order to prepare the beans for brewing and beverage formation purposes.

**11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirby (US 2,231,148) and Zapp et al. (US 6,660,322) as applied to claim 21 above and in further view of Enomoto (US 3,267,507)**

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**Regarding Claim 22:** Kirby discloses fermenting pulped coffee beans (considered green because they have not undergone processing) with a microorganism in the form of yeast and in the presence of a nutritive substance which is malt (sugar or grain) [pg.1, col.1, lines 38-55] but does not disclose grinding the roasted, fermented green coffee beans and adding water to the roasted coffee beans and then extracting water by filtration with a filter. However, Zapp discloses grinding the roasted green coffee beans [col. 1, Ex 1]. Additionally, Enomoto discloses roasting and grinding coffee beans and filtering with water through a filter basket in order to produce a coffee beverage [col.1,lines 54-68, col. 2, lines 1-25].

At the time of the invention it would have been obvious to one of ordinary skill in the art having the teachings of Kirby, Zapp, and Enomoto before him or her to grind the roasted fermented green beans of Kirby in order to prepare the beans for brewing and beverage formation purposes and to further add water and to extract the water with a filter in order to produce a coffee beverage as is known in the art. Further, adding water to ground coffee beans and filtering is a conventional method used in the art to make coffee beverages.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Boniello et al. (US 4,867,992) discloses fermenting a coffee substrate with yeast or bacteria in order to produce a particular flavor in a coffee product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FELICIA C. KING whose telephone number is (571)270-3733. The examiner can normally be reached on Mon- Thu 7:30 a.m.- 5:00 p.m.; Fri 7:30 a.m. - 4:00 p.m. alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. K./

Examiner, Art Unit 1794

/Jennifer C. McNeil/

Supervisory Patent Examiner, Art Unit 1794